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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,883	08/02/2001	Shin Iima	450100-03386	5191
20999	7590	07/15/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			CHANG, SHIRLEY	
			ART UNIT	PAPER NUMBER
			2614	
DATE MAILED: 07/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/920,883		IIMA ET AL.	
	Examiner		Art Unit	
	Shirley Chang		2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Zigmond et al. (6,698,020).

As to claim 1, Zigmond et al. disclose:

a receiving means for receiving a signal comprised of a mix of a program signal and an additional signal, ("national broadcaster 18 and cable network 30 may choose to multiplex advertisement stream 64 into video programming feeds 38 and 39" (column 18, lines 20-21); (display 61, Figure 3; display 58, Figure 4)).

a separating means for separating the program signal and the additional signal from said received signal ("As described above in reference to FIG. 3, a programming source 66, which may be operated by content provider 50, supplies video programming feed 52 to the advertisement insertion device 60. A video switch 68 toggles between video

programming feed 52 and selected advertisements of advertisement stream 64 and transmits the selected data feed to display device 58. Video switch 68 may be actuated at an appropriate time indicated by a triggering event delivered by advertisement trigger source 70" (column 8, lines 30-37); "For example, programming sources 66 such as national broadcasters or cable networks often transmit a very brief black screen immediately preceding the onset of a series of advertisements. Such a pattern may be interpreted by ad insertion device 60 and video switch 68 to be a triggering event indicating an appropriate time to insert a selected advertisement" (column 8, lines 39-54)).

a determining means for determining whether or not to output in accordance with said additional signal ("FIG. 6 is a flow chart illustrating selected steps in one embodiment of a method for inserting, an advertisement into a video programming feed using the ad insertion device 80 of FIG. 5. In step 100, the downloading of advertisements is initiated according to the methods disclosed herein. If, according to decision box 102, prefiltering is desired in order to select only certain advertisement for storage in the advertisement repository 86, the ad selection criteria are used to filter the advertisements in step 104. In step 106, the downloaded advertisements, whether prefiltered or not, are stored in advertisement repository 86" (column 17, lines 10-20)).

an output signal generating means for generating the output signal by using said separated program signal and additional signal when it is decided to output in accordance with said additional signal and for generating the output signal by using said separated program signal where it is determined not to output in accordance with said

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additional signal, an outputting means for outputting information in accordance with said generated output signal ("FIG. 6 is a flow chart illustrating selected steps in one embodiment of a method for inserting, an advertisement into a video programming feed using the ad insertion device 80 of FIG. 5. In step 100, the downloading of advertisements is initiated according to the methods disclosed herein. If, according to decision box 102, prefiltering is desired in order to select only certain advertisement for storage in the advertisement repository 86, the ad selection criteria are used to filter the advertisements in step 104. In step 106, the downloaded advertisements, whether prefiltered or not, are stored in advertisement repository 86" (column 17, lines 10-20)); (display 61, Figure 3; display 58, Figure 4; display 58, Figure 5)).

As to claim 2, Zigmond et al. disclose:

transmitting means for transmitting log information indicating a log of decisions whether or not to output in accordance with said additional signal to a transmitting side of said received signal (monitor user response 118, Figure 6; report user stats 124, Figure 6; "The ad selection criteria may be set or modified by the viewer, as well, in order to request or block advertisements for selected classes of goods or services. This optional feature of the invention advantageously allows the viewer to participate in a selection of advertisements. In an extreme case, the ad selection criteria 83 may be modified in response to, for example, increased subscription fees from the viewer in order to allow the viewer to forego advertisements altogether. In this case, advertisements may be replaced by entertainment, informational, or any other programming"(column 14, lines 24-35); "In an optional step, the viewer response to the displayed advertisement is

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monitored in step 118 according to the methods disclosed herein. When the selected advertisement is complete, the video switch resumes transmitting the video programming feed to the display device in step 120. According to decision box 122, depending on the availability of more advertisements and whether the viewer chooses to continue watching the video programming fee, the ad insertion device either selects a new advertisement in step 110 or the method proceeds to its close. If no more advertisements are to be shown, the compiled viewer response statistics are optionally reported in step 124 to the operator of the advertisement source or to a third party. If viewer response statistics are to be reported, they may be transmitted from the ad insertion device at any convenient time. Step 124 can be performed on a periodic basis, such as once per day or once per week" (column 17, lines 33-49)).

As to claim 3, Zigmond et al. disclose:

said receiving means receives a signal comprised of a mix of a program signal and an advertisement signal (met as discussed in claim 1).

As to claim 4, Zigmond et al. disclose:

a first communication apparatus for transmitting a signal comprised of a mix of a program signal and an additional signal (met as discussed in claim 1).

a second communication apparatus for receiving a signal transmitted by said first communication apparatus, said second communication apparatus comprising: a receiving means for receiving the signal transmitted by said first communication apparatus (met as discussed in claim 1).

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a separating means for separating the program signal and the additional signal from said received signal (met as discussed in claim 1).

a determining means for deciding whether or not to output in accordance with said additional signal (met as discussed in claim 1).

an output signal generating means for generating an output signal by using said separated program signal and said additional signal when it is decided to output in accordance with said additional signal and generating an output signal by using said separated program signal where it is decided not to output in accordance with said additional signal (met as discussed in claim 1).

an outputting means for outputting information in accordance with said generated output signal (met as discussed in claim 1).

As to claim 5, Zigmond et al. disclose:

said second communication apparatus further has a transmitting means for transmitting log information indicating a log of decisions of whether or not to output in accordance with said additional signal to the transmitting side of said received signal (met as discussed in claim 2).

said first communication apparatus charges the user of said first communication apparatus based on said log information received from said second communication apparatus (statistics aggregation 61, Figure 4; "The ad selection criteria may be set or modified by the viewer, as well, in order to request or block advertisements for selected

classes of goods or services. This optional feature of the invention advantageously allows the viewer to participate in a selection of advertisements. In an extreme case, the ad selection criteria 83 may be modified in response to, for example, increased subscription fees from the viewer in order to allow the viewer to forego advertisements altogether. In this case, advertisements may be replaced by entertainment, informational, or any other programming" (column 14, lines 24-35); "In an optional step, the viewer response to the displayed advertisement is monitored in step 118 according to the methods disclosed herein. When the selected advertisement is complete, the video switch resumes transmitting the video programming feed to the display device in step 120. According to decision box 122, depending on the availability of more advertisements and whether the viewer chooses to continue watching the video programming fee, the ad insertion device either selects a new advertisement in step 110 or the method proceeds to its close. If no more advertisements are to be shown, the compiled viewer response statistics are optionally reported in step 124 to the operator of the advertisement source or to a third party. If viewer response statistics are to be reported, they may be transmitted from the ad insertion device at any convenient time. Step 124 can be performed on a periodic basis, such as once per day or once per week" (column 17, lines 33-49)).

As to claim 6, Zigmond et al. disclose:

said first communication apparatus transmits a signal comprised of a mix of a program signal and an advertisement signal (met as discussed in claim 3).

performs processing for reducing a fee charged to the user of said second communication apparatus for transmission of said program signal when said advertisement signal was output in said second communication apparatus based on said log information received from said second communication apparatus (met as discussed in claim 5).

As to claim 7, Zigmond et al. disclose:

said first communication apparatus performs processing for reducing the fee charged to the user of said second communication apparatus for transmission of said program signal when said additional signal was output in said second communication apparatus based on said log information received from said second communication apparatus (met as discussed in claim 5).

As to claim 8, Zigmond et al. disclose:

said first communication apparatus charges the user of said second communication apparatus according to a condition determined in advance (met as discussed in claim 5).

As to claim 9, Zigmond et al. disclose:

said first communication apparatus transmits a signal comprised of a mix of a program signal and an advertisement signal (met as discussed in claim 1).

As to claim 10, Zigmond et al. disclose:

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an operating means operated by a user, a transmitting means for issuing a request instructing the transmission of an additional signal in accordance with operation of said operating means by said user ("The present invention relates to methods and systems for selecting and inserting advertisement into a video programming feed at the household level. The advertisements to be shown to a viewer according to the invention are selected according to designated criteria in combination with information that characterizes the viewer, the content of the video programming feed, the geographical location of the household, or the like in order to efficiently target segments of the viewing population" (column 6, lines 1-12); "In an optional step, the viewer response to the displayed advertisement is monitored in step 118 according to the methods disclosed herein. When the selected advertisement is complete, the video switch resumes transmitting the video programming feed to the display device in step 120. According to decision box 122, depending on the availability of more advertisements and whether the viewer chooses to continue watching the video programming fee, the ad insertion device either selects a new advertisement in step 110 or the method proceeds to its close. If no more advertisements are to be shown, the compiled viewer response statistics are optionally reported in step 124 to the operator of the advertisement source or to a third party. If viewer response statistics are to be reported, they may be transmitted from the ad insertion device at any convenient time. Step 124 can be performed on a periodic basis, such as once per day or once per week" (column 17, lines 33-49).

a receiving means for receiving a signal comprised of a mix of a program signal and an additional signal in accordance with said request (met as discussed in claim 1).

a separating means for separating the program signal and the additional signal from said received signal (met as discussed in claim 1).

an output signal generating means for generating an output signal by using said separated program signal and additional signal (met as discussed in claim 1).

an outputting means for output information in accordance with said generated output signal (met as discussed in claim 1).

As to claim 11, Zigmond et al. disclose:

separating a program signal and an additional signal from said received signal (met as discussed in claim 1).

determining whether or not to output in accordance with said additional signal (met as discussed in claim 1).

generating an output signal by using said separated program signal and additional signal where it is decided to output in accordance with said additional signal (met as discussed in claim 1).

generating an output signal by using said separated program signal when it is decided not to output in accordance with said additional signal (met as discussed in claim 1).

outputting information in accordance with said generated output signal (met as discussed in claim 1).

As to claim 12, Zigmond et al. disclose:

transmitting log information indicating a log of decision of whether or not to output in accordance with said additional signal from said reception side to the transmission side (met as discussed in claim 2).

charging said reception side user based on said log information on said transmission side (met as discussed in claim 5).

As to claim 13, Zigmond et al. disclose:

transmitting a signal comprised of a mix of a program signal and advertisement signal therein from said transmission side to said reception side (met as discussed in claim 3).

having said transmission side perform processing for reducing a fee charged to said reception side user for transmission of said program signal where said advertisement signal is output on said reception side based on said log information received from said reception side (met as discussed in claim 6).

As to claim 14, Zigmond et al. disclose:

a step of processing for increasing the fee charged to said reception side user for transmission of said program signal on said transmission side when said additional

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signal is output on said reception side based on said log information received from said reception side (met as discussed in claim 6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC


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